

Appl. No. 10/004,786
Amdt. Dated May 18, 2005
Reply to Office action of February 18, 2005
Attorney Docket No. P13026-US2
EUS/J/P/05-1124

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicants have amended claims 1, 3, 5, 7-8, 10-13 and 17-22 to more particularly point out and distinctly claim the subject matter the Applicants regard as the invention; no new matter has been added. Claims 2, 4, 6 and 9 have been cancelled. Accordingly, claims 1, 3, 5, 7-8 and 10-25 remain pending in the application.

2.) Examiner Objections – Oath/Declaration

The Examiner objected to the oath or declaration because of non-initialed and/or non-dated alterations contained therein. The Applicants submit herewith a newly executed Combination Declaration and Power of Attorney.

3.) Claim Rejections-35 U.S.C. §112

The Examiner rejected claims 5, 7, 8, 10-12 and 19-22 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants have amended those claims to remove the terms the Examiner stated rendered the claims indefinite.

4.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 1, 2, 7, 11 and 13-17 as being unpatentable over Beach (US 6,067,297) and Larsson, *et al.* (US 6,463,307); claims 3, 4, 10, 12, 18 and 23 as being unpatentable over Beach and van Bokhorst, *et al.* (US 6,192,230); claims 5, 6, 8, 9, 19-22, 24 and 25 as being unpatentable over Beach and van Bokhorst and further in view of Chen, *et al.* (US 5,502,724). The Applicants traverse the rejections.

In rejecting claim 1, it appears that the Examiner has found certain similar claim elements in the reference patents, but those patents are not directed to the problem addressed by the Applicants' invention. Beach does not address the problems described in the Applicants disclosure regarding the power states of a mobile terminal and a NIC therein. The problem according to the Applicants' invention concerns the cooperation between a mobile terminal and its NIC, wherein the power states of the

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mobile terminal and NIC may interact and prohibit a lower power status of one depending on the status of the other. An interesting aspect of Applicants' invention is that both the mobile terminal and the NIC can enter power save states; i.e., it is not only the mobile terminal itself that can power down.

The teachings of Beach relate to a WLAN, using the IEEE 803.2 protocol; specifically, the protocol aspects regarding frequency hopping, especially frequency hopping spread spectrum communication. The mobile units may operate in two power management modes, either continuously awake mode (CAM) or power save polling (PSP) mode. In contrast, the Applicants' invention sends requests between the devices to find out the devices power states. That knowledge allows the apparatus to shut down as low as possible in the different parts (mobile terminal and NIC). To overcome the deficiencies of Beach, the Examiner looks to the teachings of Larson.

The teachings of Larson relate to the interaction between a terminal and a base station, and the hibernation state of the terminal and the ability to decide during hibernation whether a packet is waiting to be sent. Larson essentially discloses:

1. An awake terminal sends hibernation request to base station; and,
2. the base station sends instructions with time intervals when base station should listen;

and,

1. Base station decides while in hibernating mode that it has a package to send; and,
2. the base station awakes itself and sends capacity request signal to initiate transfer of packet.

Those teachings of Larson do not deal with deciding if a change of power status is possible as is the problem addressed by Applicants' invention. In rejecting Applicant's invention, the Examiner has impermissibly used hindsight by reading back into the prior art the teachings of Applicant's own disclosure. The Examiner has used Applicants' claims as a blueprint to pick and chose elements from the prior art similar to Applicants' individual claim limitations, without regard to the manner in which those limitations have been combined by Applicant to effect a novel and useful improvement to the state of the art. Various bits of data or teachings of the prior art are not properly combined unless

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there is something in the prior art itself that suggests that those teachings could or should be combined. Both the suggestion for combining teachings to make the invention and its reasonable likelihood of success "must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem.* 837 F.2d 469, 473 (Fed. Cir. 1988). Because the Examiner has failed to meet that burden, he has failed to establish a *prima facie* case of obviousness and, therefore, claim 1 should be allowed.

For the same reasons, the Examiner has failed to establish a *prima facie* case of obviousness of independent claims 3, 5, 8, 13 and 17-18. Furthermore, whereas claims 7, 11 and 16 are dependent from claim 1; claims 10, 12 and 23 are dependent from claim 3; claims 19, 21 and 24 are dependent from claim 5; claims 20, 22 and 25 are dependent from claim 8; and claims 14 and 15 are dependent from claim 13, and include the limitations of their respective base claims, those claims are also not obvious in view of Beach, Larsson, van Bokhorst, or Chen, either individually or in combination.

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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1, 3, 5, 7-8 and 10-25.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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